



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/326,020	06/04/99	PORTER	J CELL-0072

HM12/0129
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EXAMINER	
ROBINSON, B	
ART UNIT	PAPER NUMBER

1625

DATE MAILED: 01/29/01

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/326,020

Applicant(s)

Porter Et. Al.

Examiner
Binta Robinson

Group Art Unit
1625



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-19 _____ is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-19 _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-19, drawn to a compound of formula (Ia) in claim 1 where R1 is an optionally substituted phenyl, a method of treating a disease selected from the group consisting of inflammatory arthritis, multiple sclerosis, allograft rejection, diabetes, inflammatory dermatoses, asthma, and inflammatory bowel disease, a method of inhibiting an alpha 4 beta 7 integrin binding to ligands utilizing compounds of formula (Ia), and a pharmaceutical composition classified in class 546, subclass 326 and other subclasses, class 514, subclass 354 and other subclasses.
 - II. Claims 1-19, drawn to a compound of formula (Ia) in claim 1 where R1 is an optionally substituted pyridyl, a method of treating a disease selected from the group consisting of inflammatory arthritis, multiple sclerosis, allograft rejection, diabetes, inflammatory dermatoses, asthma, and inflammatory bowel disease, a method of inhibiting an alpha 4 beta 7 integrin binding to ligands utilizing compounds of formula (Ia), and a pharmaceutical composition classified in class 546, subclass 326 and other subclasses, class 514, subclass 354 and other subclasses.
 - III. Claims 1-19, drawn to a compound of formula (Ia) in claim 1 where R1 is an optionally substituted pyrimidinyl group, method of treating a disease selected

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from the group consisting of inflammatory arthritis, multiple sclerosis, allograft rejection, diabetes, inflammatory dermatoses, asthma, and inflammatory bowel disease, a method of inhibiting an alpha 4 beta 7 integrin binding to ligands utilizing compounds of formula (Ia), and a pharmaceutical composition classified in class 546, subclass 326 and other subclasses, and class 514, subclass 354 and other subclasses.

2. Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions can be used as inhibitors of beta amyloid protein production (See Cordell et. al., Reference N) or as protease inhibitors (See Okamoto et. al., Reference O)
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. A telephone call was made to Greg Hillyer on 1/24/01 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta Robinson whose telephone number is (703)306-5437.

The examiner can normally be reached on Monday through Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. John Kight, can be reached on (703)308-0204. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.


BMR

January 25, 2001


ALAN L. ROTMAN
PRIMARY EXAMINER